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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,075	11/03/2003	Mark M. Josephsen	100202485-1	3736

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EXAMINER
KOEMPEL THOMAS, BEATRICE L

ART UNIT	PAPER NUMBER
2196	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/700,075

Applicant(s)

JOSEPHSEN ET AL.

Examiner

Bea Koempel-Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are pending in this application and presented for examination.

Objections

Specification

1. The disclosure is objected to because of the following informalities: Apparent editing notation "Duplicate?" not deleted (page 5 line 15).

Appropriate correction is required.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the security module" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 4, 9, 13, 18, 20, and 21 objected to because of the following informalities:
4. In claims 4 and 13 "the symmetric key" lacks antecedent basis. When examining the claims, the examiner interpreted "the symmetric key" as "a symmetric key."

In claims 9 and 18 "the attached printer" (line 2) appears to be in error. When examining the claims, the examiner interpreted "the attached printer" in line 2 of claims 9 and 18 as "the attached computer" for which antecedence is provided in independent claims 1 and 10, respectively.

In claims 20 and 21 the preamble and body of the claim contain inconsistent terminology. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-9 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 19 could reasonably be drawn to functional descriptive material, per se, i.e., "security module" may be taken to mean software

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alone, and as such, claims 1-9 and 19, would be directed to non-statutory subject matter. The specification does not preclude this interpretation. Further, claims 1-9 and 19 do not transform a physical object to a different state or thing nor produce a useful, concrete and tangible result.

7. Claims 1, 19, and 20 are rejected under 35 U.S.C. 101 because the claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which sets forth the statutory classes of invention in the alternative only. *Ex parte Lyell*, 17 USPQ2d 1551 (Bd. Pat. App. & Inter. 1990).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for attempting to claim both an apparatus and the method steps of using the apparatus. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Claim 1 attempts to claim both a security module and the security module's method of operation in the same claim, thereby rendering claim 1 indefinite. Claim 19 attempts to claim both a peripheral device module and the peripheral device module's method of operation in the same claim, thereby rendering claim 19 indefinite. Claim 20 attempts to claim both a computer printer system and the computer printer system's method of operation in the same claim, thereby rendering claim 20 indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 4, 5, 9-11, 13, 14, and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Partelow et al., U.S. Patent Publication No. 2004/0008842 A1, (hereinafter “Partelow”).

12. Regarding **claim 1**: Partelow discloses a security module ([0017] lines 1-3) within a printer that is operable to:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key([0018] line 7).

13. Regarding **claim 10**: Partelow discloses a machine-readable medium ([0015] lines 11-12) with instructions stored thereon, the instructions when executed operable to cause a computerized printer ([0017] line 1) to:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key ([0018] line 7).

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14. Regarding **claims 2 and 11**: Partelow discloses a generated key comprising a symmetric encryption key ([0021] lines 1-7).

15. Regarding **claims 4 and 13**: Partelow discloses a symmetric key is a DES key ([0021] line 7).

16. Regarding **claims 5 and 14**: Partelow discloses that generating a key comprises generating a public key and a private key ([0021] line 8), and sending the key to the attached computer requesting the key comprises sending the public key to the attached computer requesting the key ([0025] line 3).

17. Regarding **claims 9 and 18**: Partelow discloses that the attachment between the printer and the attached computer is a network attachment ([0013] line 3).

18. Regarding **claim 19**: Partelow discloses a peripheral device module ([0017] lines 1-3) executable within the computerized peripheral device that when executed is operable to:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key([0018] line 7).

19. Regarding **claim 20**: Partelow discloses a computer printer system ([0013] lines 4-6), comprising:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key([0018] line 7).

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20. Regarding **claim 21**: Partelow discloses a method of managing a printer in a computerized system external to the printer ([0019] lines 1-3), comprising:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key([0018] line 7).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 3, 6, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow in view of Berstis et al., U.S. Patent No. 6,282,653 B1, (hereinafter "Berstis").

23. Regarding **claims 3, 6, 12 and 15**: Partelow does not disclose sending the key to the attached computer over a secured connection.

Berstis discloses sending the key to the attached computer over a secured connection (col. 7 line 5).

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Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by the secured connection as taught by Berstis in order to protect the content (key) from unauthorized access.

24. Claims 7, 8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow in view of Lee, U.S. Patent No. 6,628,413 B1, (hereinafter "Lee").

25. Regarding **claims 7 and 16**: Partelow does not disclose receiving the message from an attached computer via a web server hosted within the printer.

Lee discloses receiving the message from an attached computer via a web server hosted within the printer (col. 3 lines 52-54).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by web server taught by Lee for the benefit of Internet accessible printing.

26. Regarding **claims 8 and 17**: Partelow does not disclose a Java virtual machine within the printer.

Lee discloses a Java virtual machine within the printer (col. 3 lines 64-65).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by the Java Virtual Machine taught by Lee in order to have portability when new processors become available.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is:

- Bernklau-Halvor, U.S. Patent Publication No. 2003/0110413 A1, regarding a method for analyzing printer faults.
- Hansen, U.S. Patent Publication No. 2003/0101342 A1, regarding a secure printing system and method.
- Iwata, U.S. Patent No. 6,778,289 B1, regarding an Internet connected image processing device.
- Sasaki, U.S. Patent Publication No. 2003/0234948 A1, regarding a system, method, and data structure for print data management.
- Wu et al., U.S. Patent Publication No. 2002/0042884 A1, regarding remote printing of secure and/or authenticated documents.

Please direct any inquiry concerning this communication or earlier communications from the examiner to Bea Koempel-Thomas whose telephone number is 571-270-1252. The examiner can normally be reached on Monday - Thursday & alternate Fridays; 0730 - 1700.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Nabil El-Hady, on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bkt  10/14/2006

N. S. Hady